

## **REMARKS**

The Examiner is thanked for the thorough examination of the present application. The Office Action, however, has tentatively rejected all claims 1-9. Specifically, the Office Action has rejected claims 1-3 under 35 U.S.C. § 102(e) as allegedly anticipated by U.S. publication 2004/0160435 to Cui, et al. Claims 4-9 have been rejected under 35 U.S.C. § 103(a) as unpatentable over Cui in view of one or more cited references.

Applicant has amended independent claim 1 (the only independent claim in this application) to clearly define features of embodiments of the present invention over the cited art. In view of the foregoing amendments and following remarks, Applicant requests that all rejections be reconsidered and withdrawn. Specifically, claim 1 has been amended to include certain limitations of claims 2, 4, 5, and 7, which define embodiments of the present patent application. Furthermore, claims 2, 4, 5, and 7 and have been cancelled by this Amendment.

### **Rejection Under 35 U.S.C. § 112, first paragraph**

The Office Action rejected claim 7 under 35 U.S.C. §112, first paragraph. This rejection has been rendered moot by the cancellation of claim 7.

### **Rejections Under 35 U.S.C. § 102(e)**

The Office Action rejected claims 1-3 under 35 U.S.C. § 102(b) as allegedly anticipated by Cui. For at least the following reasons, Applicant respectfully requests reconsideration and withdrawal of the rejections.

As amended, independent claim 1 recites:

1. A power-saving method for video-broadcasting system in liquid crystal display (LCD) equipment, wherein said liquid crystal display (LCD) equipment, includes a computer and an LCD, said power-saving method mainly comprising the steps of:

*outputting a command about brightness of a back light source and a command about video information;*

*decreasing brightness of the back light according to the command about brightness of the back light source; and*

*increasing brightness information and contrast information according to the command about video information.*

(*Emphasis added.*) Claim 1 patently defines over Cui for at least the reason that Cui fails to disclose the features emphasized above.

Specifically, Cui does not disclose the step of outputting commands about a back light source and video information, and does not disclose the steps of decreasing brightness of the back light source, increasing brightness information and contrast information according to the outputting commands.

The Office Action alleged that "it is inherent for Cui to output commands about a back light source and video information." Applicants therefore submit that the rejection of the Office Action constitutes legal error (contrary to well-established Federal Circuit precedence regarding the law of surrounding inherent teachings). In fact, the undersigned respectfully directs the Examiner's attention to the recent decision of *Elan Pharms. v. Mayo Found. for Med. Educ. & Research*, 304 F.3d 1221 (Fed. Cir. 2002), in which the Federal Circuit reversed a finding of inherency by a district court. In this opinion, the Court of Appeals for the Federal Circuit noted:

An anticipating reference "must disclose every element of the challenged claim and enable one skilled in the art to make the anticipating subject matter." *PPG Industries, Inc. v. Guardian Industries Corp.*, 75 F.3d 1558, 1566, 37 USPQ2d 1618, 1624 (Fed. Cir. 1996). When anticipation is based on inherency of limitations not expressly disclosed in the assertedly anticipating reference, it must be shown that the undisclosed information was known to be present in the subject matter of the reference. *Continental Can Co. USA, Inc. v. Monsanto Co.*, 948 F.2d 1264, 1269, 20 USPQ2d 1746, 1749-50 (Fed. Cir. 1991). *An inherent limitation is one that is necessarily present; invalidation based on inherency is not*

*established by "probabilities or possibilities."* *Scaltech, Inc. v. Retec/Tetra, LLC.*, 178 F.3d 1378, 1384, 51 USPQ2d 1055, 1059 (Fed. Cir. 1999).

This discussion by the Federal Circuit is certainly nothing new. The law surrounding the doctrine of inherency has not changed for over 60 years. In fact, the Federal Circuit has repeatedly quoted the language from the 1939 decision *Hansgirg v. Kemmer*, 26 C.C.P.A. 937, 102 F.2d 212, 214, 40 U.S.P.Q. (BNA) 665, 667 (CCPA 1939)), which stated:

Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient. [Citations omitted.] If, however, the disclosure is sufficient to show that the natural result flowing from the operation as taught would result in the performance of the questioned function, it seems to be well settled that the disclosure should be regarded as sufficient.

In the present situation, the Office Action has, unfortunately, substituted its own subjective judgment in place of the actual teachings of the *Cui* reference. It is clear that *Cui* fails to teach, as alleged by the Office Action, that brightness is increased and/or decreased according to the command, as required by claim 1 of the present application. For at least this additional reason, the rejection of claim 1 should be withdrawn.

For at least this reason, independent claim 1 patently defines over the cited art. As all remaining claims depend from claim 1, the rejections of all remaining claims should be withdrawn.

#### **Rejections Under 35 U.S.C. § 103(a)**

The Office Action rejected claims 4-9 under 35 U.S.C. § 103(a) as allegedly unpatentable over *Cui* in view of U.S. patent 6,963,329 to Lee. Applicant respectfully requests reconsideration and withdrawal of this rejection for at least the following reasons.

In the Official Action, the Examiner rejected Claims 4-9 under 35 U.S.C. § 103(a) as being unpatentable over Cui in view of Lee (US # 6,963,329 B2).

Lee teaches the controlling method for automatically controlling the brightness of a back light source according to a contrast sensed so as to be a waste of electric power.

However, the power-saving method of the present invention outputs a command about decreasing brightness of the back light source and another command about increasing contrast information. Therefore, the power-saving method doesn't automatically control the brightness of the back light source following the contrast sensed as Lee but also decrease the brightness of the back light source and increase the contrast separately according with the outputting commands to achieve the power-saving.

Furthermore, the power-saving method doesn't use an input impedance for sensing the contrast sensed, so the power-saving method is simpler than Lee's teaching. Therefore, amendment to the claim 1 has overcome the Examiner's rejection, and should be allowable.

It is now believed that the subject Patent Application has been placed in condition for allowance and such action is respectfully requested.

#### **Independent basis for patentability of Claims 4-9**

As a separate and independent basis for the patentability of claims 4-9, Applicant respectfully traverses the rejections as failing to identify a proper basis for combining the cited references. In combining these references, the Office Action stated only that the combination would have been obvious "to reduce a waste of electrical power in a portable computer system."

(Office Action, page 5). This alleged motivation is clearly improper in view of well-established Federal Circuit precedent.

It is well-settled law that in order to properly support an obviousness rejection under 35 U.S.C. § 103, there must have been some teaching in the prior art to suggest to one skilled in the art that the claimed invention would have been obvious. W. L. Gore & Associates, Inc. v. Garlock Thomas, Inc., 721 F.2d 1540, 1551 (Fed. Cir. 1983). More significantly,

"The consistent criteria for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this [invention] should be carried out and would have a reasonable likelihood of success, viewed in light of the prior art. ..." Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure... In determining whether such a suggestion can fairly be gleaned from the prior art, the full field of the invention must be considered; for the person of ordinary skill in the art is charged with knowledge of the entire body of technological literature, including that which might lead away from the claimed invention."

(*Emphasis added.*) In re Dow Chemical Company, 837 F.2d 469, 473 (Fed. Cir. 1988).

In this regard, Applicant notes that there must not only be a suggestion to combine the functional or operational aspects of the combined references, but that the Federal Circuit also requires the prior art to suggest both the combination of elements and the structure resulting from the combination. Stiftung v. Renishaw PLC, 945 Fed.2d 1173 (Fed. Cir. 1991). Therefore, in order to sustain an obviousness rejection based upon a combination of any two or more prior art references, the prior art must properly suggest the desirability of combining the particular elements to derive a power saving method, as claimed by the Applicant.

When an obviousness determination is based on multiple prior art references, there must be a showing of some "teaching, suggestion, or reason" to combine the references. Gambro Lundia AB v. Baxter Healthcare Corp., 110 F.3d 1573, 1579, 42 USPQ2d 1378, 1383 (Fed. Cir. 1997) (also noting that the "absence of such a suggestion to combine is dispositive in an

obviousness determination").

Evidence of a suggestion, teaching, or motivation to combine prior art references may flow, *inter alia*, from the references themselves, the knowledge of one of ordinary skill in the art, or from the nature of the problem to be solved. See In re Dembiczak, 175 F.3d 994, 1000, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Although a reference need not expressly teach that the disclosure contained therein should be combined with another, the showing of combinability, in whatever form, must nevertheless be "clear and particular." Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617.

If there was no motivation or suggestion to combine selective teachings from multiple prior art references, one of ordinary skill in the art would not have viewed the present invention as obvious. See In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); Gambro Lundia AB, 110 F.3d at 1579, 42 USPQ2d at 1383 ("The absence of such a suggestion to combine is dispositive in an obviousness determination.").

Significantly, where there is no apparent disadvantage present in a particular prior art reference, then generally there can be no motivation to combine the teaching of another reference with the particular prior art reference. Winner Int'l Royalty Corp. v. Wang, No 98-1553 (Fed. Cir. January 27, 2000).

For at least the additional reason that the Office Action failed to identify proper motivations or suggestions for combining the various references to properly support the rejections under 35 U.S.C. § 103, those rejections should be withdrawn.

## CONCLUSION

In view of the foregoing, it is believed that all pending claims are in proper condition for allowance.

Should the Examiner have any questions regarding this response, the Examiner is invited to telephone the undersigned attorney at (770) 933-9500.

No fee is believed to be due in connection with this amendment and response to Office Action. If, however, any fee is believed to be due, you are hereby authorized to charge any such fee to deposit account No. 20-0778.

Respectfully submitted,



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